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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,811	04/15/2004	Yen-Fu Chen	AUS920031072US1	6690
37945	7590	08/21/2009		
DUKE W. YEE YEE AND ASSOCIATES, P.C. P.O. BOX 802333 DALLAS, TX 75380			EXAMINER BELANI, KISHIN G	
			ART UNIT 2443	PAPER NUMBER
			NOTIFICATION DATE 08/21/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary

Application No.

10/824,811

Applicant(s)

CHEN ET AL.

Examiner

KISHIN G. BELANI

Art Unit

2443

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37, 39, 40, 42, 43 and 45 is/are rejected.
- 7) ☒ Claim(s) 38, 41, and 44 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is in response to Applicant's RCE filed on 06/10/2009. **Independent claim 36 has been cancelled. New claims 37-45 have been added. Claims 37-45 are now pending** in the present application.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/10/2009 has been entered.

Drawings

The drawings are objected to because of mismatching topic names in Figs. 6C and 6D. To be consistent with the rest of the figures showing Topic B as "Project", please change the Topic B name in Figs. 6C and 6D from "Dinner" to "Project". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an

amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 39 is objected to because of the following informalities:

Claim 39 preamble refers to "The computer-implemented process of claim 37", wherein claim 37 states "a computer-implemented method". The examiner has interpreted "process" as a "method" claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 37, 40, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Brown et al. (US Patent Application Publication # 2003/0023684 A1)** in view of **Briggs et al. (US Patent Publication # 7,080,139 B1)** and further in view of **Bogard (US Patent Publication 6,757,365 B1)**.

Consider **claims 37, 40, and 43**, Brown et al. show and disclose a computer implemented method (and apparatus and computer program product) comprising: responsive to a first input to a computer by a first user of an instant messaging service adapted for sending and receiving a plurality of text messages in real time between the first user and a second user, determining, by a processor of the computer, that a topic tag is to be inserted into a text message of an instant messaging session, wherein the instant messaging service is adapted to accept the first input before the instant messaging session begins, during the instant messaging session, and after the instant messaging session; and responsive to the acceptance, automatically inserting the topic tag, by the processor, into the text of the instant messaging session (Fig. 2 that shows an instant messaging service adapted for sending and receiving a plurality of text messages in real time between the first user and a second user; paragraph 0063 describes the details of the messaging service; Fig.3 that shows the details of the messaging server 50, including a messaging controller 62; and paragraph 0073 which teaches that a sending user (a first user) may select the attributes for a particular topic (a first input) and then initiate that topic); further disclosing that the messaging controller 62 allows users to customize messaging output before, during, and after a session; paragraph 0069 which further discloses that as messaging server 50 receives messages (i.e. after the second user's response of accepting the first user's selected topic), they are stored according to channel, topic, and sending user and then distributed to each of the receiving users participating in that channel; paragraph 0074 which teaches that multiple windows each associated with a particular topic may be

initiated between two users participating in the instant messaging session, wherein a window associated with a particular topic may be left open, but may be indicated as an old conversation, while a new topic window may be designated as a new conversation, and flowchart of Fig. 4 with paragraphs 0075-0077 which disclose that addition of a new topic requires comparing the new topic with current topics open in the current channel, and if the new topic does not match any of the current topics, adding the new topic tag to the channel, thereby disclosing that responsive to a first input to a computer by a first user, determining, by a processor of the computer, that a topic tag is to be inserted into a text message).

However, Brown et al. do not specifically disclose responsive to a second input to the computer by the second user, determining by the processor, an acceptance of the topic tag by the second user; and when a turn is identified by the processor, wherein a turn means a shift in a textual communication during the instant messaging session indicated by a plurality of successive statements.

In the same field of endeavor, Briggs et al. show and disclose the claimed method (and apparatus and computer program product), wherein responsive to a second input to the computer by the second user, determining by the processor, an acceptance of the topic tag by the second user (Fig. 8D that shows a topic sharing interface, with topics/subtopic list 892 and checkboxes 891 that any receiving user may click in to indicate to the processor an acceptable topic, or check it off to reject the topic previously selected by another user; column 8, lines 42-45 which disclose that each user will be able to turn the displayed topic areas on or off).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to determine, by the processor, responsive to a second input to the computer by the second user, an acceptance of the topic tag by the second user, as taught by Briggs et al., in the method (and apparatus and computer program product) of Brown et al., so that an instant messaging session with the mutually acceptable topic identified in a new topic window may be started.

However, Brown et al., as modified by Briggs et al., do not specifically disclose when a turn is identified by the processor, wherein a turn means a shift in a textual communication during the instant messaging session indicated by a plurality of successive statements.

In the same field of endeavor, Bogard shows and discloses the claimed method (and apparatus and computer program product), including when a turn is identified by the processor, wherein a turn means a shift in a textual communication during the instant messaging session indicated by a plurality of successive statements (column 10, lines 19-38 which show how an introductory conversation topic about using a particular instant messaging service turns to a registration topic when the customer responds with a "No" to a question from the system), wherein a turn means a shift in a textual communication during the instant messaging session indicated by a plurality of successive statements about the registration process).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to identify a turn by the processor, wherein a turn means a shift in a textual communication during the instant messaging session

indicated by a plurality of successive statements, as taught by Bogard, in the method (and apparatus and computer program product) of Brown et al., as modified by Briggs et al., so as to mark different topics of discussion in order to later identify and understand which topics were discussed during the session.

Claims 39, 42, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Brown et al. (US Patent Application Publication # 2003/0023684 A1)** in view of **Briggs et al. (US Patent Publication # 7,080,139 B1)** and further in view of **Bogard (US Patent Publication # 6,757,365 B1)** and further in view of **St. John et al. (US Patent Application Publication # 2006/0004702 A1)**.

Consider **claims 39, 42, and 45** and as they respectively apply to **claims 37, 40, and 43 above**, Brown et al., as modified by Briggs et al., and Bogard, further show and disclose the claimed method for claim 39 (and apparatus for claim 42, and computer program product for claim 45), further comprising:
saving a transcript of the instant messaging session to a repository (in Brown et al. reference, Fig. 8, block 266 that shows storing message in temporary message file before formatting and distributing the message; paragraph 0091 discloses the same details); and
searching the repository for the topic tag (Fig. 3, Search entry window 371 and Search (Find) button 372 that are used to enter topic tag by the user, and based on the tag entered, the repository is searched for the content associated with the tag; also Fig. 9,

messages tab 965 that provides access to the message repository; filters 971-973 that provide for a narrower focused search; column 6, lines 37-51 and column 8, line 56 through column 9, line 14 disclose the same details).

However, Brown et al., as modified by Briggs et al., and Bogard, do not explicitly disclose that responsive to determining that there is a match between the topic tag in the repository and an entry in an auto alert table, exporting an associated transcript segment to an e-mail.

In the same field of endeavor, St. John et al. further show and disclose the claimed method (and apparatus and computer program product), wherein responsive to determining that there is a match between the topic tag in the repository and an entry in an auto alert table, exporting an associated transcript segment to an e-mail (Fig. 1, Active DB 14 and Fig. 6; paragraphs 0061-0063 which disclose that information items and their associated gists are stored in database 14, wherein each client can query (scanning topic tags) the database to obtain information about the topics of interest to the client; further disclosing handling auto alerts by the document server 8, wherein the auto alert contains at least the item identifier of the involved information item and the category of the terms that trigger the auto alert, and the client manager searches the client profiles (auto-alert tables) to identify each client to whom the identified item is to sent, and further indicating that the auto-alert message may take the form of an e-mail containing the information item).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to export, responsive to determining that there is a

match between the topic tag in the repository and an entry in an auto alert table, an associated transcript segment to an e-mail, as taught by St. John et al., in the method (and apparatus and computer program product) of Brown et al., as modified by Briggs et al., and Bogard, in order to deliver the information for the selected topic to each user who requested the information.

Allowable Subject Matter

Claims 38, 41, and 44 are objected to as being dependent upon rejected base claims 37, 40, and 43, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Consider **claims 38, 41, and 44**. The best prior art found during the examination of the present application, **Brown et al. (US Patent Application Publication # 2003/0023684 A1)**, **Briggs et al. (US Patent Publication # 7,080,139 B1)**, and **Bogard (US Patent Publication 6,757,365 B1)**, fail to disclose the graphical user interface described in claims 38, 41, and 44. Specifically, none of the cited prior art shows, describes, or suggests four different areas for displaying the chat transcript of the instant messaging session in the first area, with a topic list at the end of the chat transcript and two sub-topic tabs, such that when a topic from the displayed topic list is selected, the corresponding instant message transcript segment is shown in the second area; when the first sub-topic tab is selected, the corresponding instant message transcript segment is shown in the third area, and when the second sub-topic tab is

selected, the corresponding instant message transcript segment is shown in the fourth area.

Therefore, claims 38, 41, and 44 are considered novel and non-obvious, and therefore allowable, if written in independent form including all of the limitations of the base claims 37, 40, and 43.

Response to Arguments

Applicant's arguments with respect to claims 37-45 have been considered but are moot in view of all new claims presented, necessitating new ground(s) of rejection.

Conclusion

Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

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Art Unit: 2443

Hand-delivered responses should be brought to

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401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kishin G. Belani whose telephone number is (571) 270-

1768. The Examiner can normally be reached on Monday-Friday from 6:00 am to 5:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tonia Dollinger can be reached on (571) 272-4170. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-0800.

/K. G. B./
Examiner, Art Unit 2443

August 11, 2009

/Tonia LM Dollinger/
Supervisory Patent Examiner, Art Unit 2443